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10/826,100	04/15/2004	Denis E. Ryono	LA0120 NP	9349
23914 7590 03/18/2008 LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000				
EXAMINER OH, TAYLOR V				
ART UNIT		PAPER NUMBER		
1625				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Art Unit: 1625

It is noted that applicants have filed an Amendment after the Final Rejection on 2/13/08; applicants' attorney has addressed the issues of record. The proposed amendment will be not entered; and, it is not in a condition for allowance because applicants still did not resolve the issue of the 102(b) rejection.

The Status of Claims

Claims 1-7, and 16-17 are pending.

Claims 1-7 and 16-17 are rejected.

Claim Objections

The objection of claims 1 and 17 can be overcome by the proposed modification of claim 1 cancellation of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 1-7 and 16 under 35 U.S.C. 112, first paragraph, can be overcome by the proposed modification of claim 1 cancellation of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 17 under 35 U.S.C. 112, second paragraph, can be overcome by the proposed modification of claim 17.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Plattner (US 4,389,416).

The rejection of 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Plattner (US 4,389,416) is maintained for the reasons of the record on 3/23/07.

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Applicants' Argument

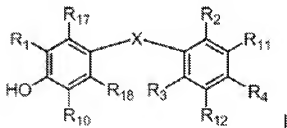
Applicants argue the following issues:


Applicants have amended Claim 1 by removing the negative proviso and by deleting alkyl as an R10 substituent. The amendment to Claim 1 is considered to overcome the rejection under 102(b) and withdrawal of the rejection is respectfully requested.

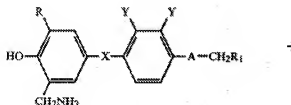
Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding applicants' argument, the Examiner has noted applicant's argument.

However, in claim 1, the formula is



Wherein R1 is . This compound can be found in the prior art (see below):



wherein R is hydrogen, loweralkyl, aminomethyl or halo; R₁ is carboxy, carboxyloweralkyl, aminocarbonyl, hydroxymethyl, anilinomethyl, or aminomethyl; A is oxygen, CH₂, Sulfur or a single bond; X is oxygen, CH₂, sulfur or sulfoxide; and Y is hydrogen, loweralkyl or halo and may be the same or different, and pharmaceutically acceptable salts thereof.

The compounds are effective as diuretic agents.

TABLE I-continued

Compound	R	R ₁	X	A	ED ₂
12	H	—COOC ₂ H ₅	0	CH ₂	25
13	H	—COOC ₂ H ₅	0	bond	21.5

(see col. 16 , table 1, examples 12 and 13)

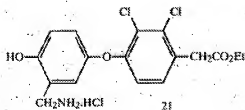
EXAMPLE 12

Ethyl

2,3-dichloro-4-[(3'-benzyloxycarboxamidomethyl-4'-hydroxy)phenoxy]phenoxyacetate

EXAMPLE 13

2,3-Dichloro-4-[(3'-aminomethyl-4'-hydroxy)phenoxy]-phenoxyacetamide, hydrobromide



(see col. 5 ,line 30) .

Therefore, unlike applicants' argument , this is identical with the claims. Therefore, the prior art is still relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625

3/6/08
